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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,079	10/27/2000	Donna K. Fox	0942.4460002/RWE/BJD	7547

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EXAMINER

JOHANNSEN, DIANA B

ART UNIT PAPER NUMBER

1634

DATE MAILED: 07/31/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/697,079

Applicant(s)

FOX ET AL.

Examiner

Johannsen

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 45-49 and 52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-49 and 52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*.

### **DETAILED ACTION**

1. This action is in response to paper no. 13, filed May 8, 2002. Claims 45-49 and 52 are pending. Applicants' arguments in paper no. 13 have been thoroughly reviewed. Any rejections not reiterated in this action have been withdrawn. **This action is NON-FINAL.**

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Rejections Withdrawn***

3. Applicants' arguments in paper no. 13 regarding the loss of the polymerase inhibitor function of antibodies TthStart and TaqStart during the initial denaturation step of PCR are persuasive. Accordingly, the following rejections are withdrawn:

- a) The rejection of claims 45-47, 49, and 52 under 35 USC 102(e) as being clearly anticipated by Chenchik et al;
- b) The rejection of claims 45-49 and 52 under 35 USC 102(e) as being clearly anticipated by Okura et al; and
- c) The rejection of claim 48 under 35 USC 103(a) as being unpatentable over Chenchik et al.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 45-49 and 52 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Todd (WO 96/32500 [10/1996]).

Todd et al disclose a composition comprising a restriction endonuclease, anti-*Taq* polymerase antibodies, and multiple buffers (see entire reference, especially p. 19, lines 11-21; page 22, lines 8-21). With respect to claim 49, it is noted that the claim is sufficiently broad so as to encompass storage under any type of conditions for any length of time, and it is an inherent property of the compositions taught by Todd et al that they would be "stable upon storage" under appropriate conditions (e.g., in a freezer). Accordingly, Todd et al clearly anticipate the claims.

6. Claims 45-46, 49 and 52 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the GibcoBRL Life Technologies Catalogue and Reference Guide (page 6-29, 1993-1994).

The GibcoBRL Catalogue teaches compositions comprising restriction endonucleases (specifically, *NarI* and *NcoI*) as well as the metal chelator EDTA and the sulfhydryl reagent 2-mercaptoethanol (p. 6-29; see section under each enzyme name entitled "Concentration in storage buffer"). With respect to claim 49, the compositions taught by the GibcoBRL Catalogue comprise enzymes in "storage buffer," and it is an inherent property of the compositions that they are "stable upon storage." With respect to claim 52, the compositions of the GibcoBRL Catalogue include the buffer Tris-HCl. Accordingly, the GibcoBRL Catalogue clearly anticipates the claims.

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**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 703/305-0761. The examiner can normally be reached on Monday-Friday, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on 703/308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0196.

Diana B. Johannsen  
July 25, 2002

  
CARLA J. MYERS  
PRIMARY EXAMINER